

REMARKS

In response to the final Office Action mailed on October 5, 2009, Applicant respectfully requests reconsideration of all rejections in the outstanding Office Action in view of the foregoing amendments and following remarks. Claims 1-15 are currently pending.

I. Request for Interview

In the event that there are any issues left unresolved by this Reply, the Examiner is respectfully requested to contact the undersigned to schedule a telephonic interview prior to issuance of another Office Action. Applicant believes that an interview will greatly assist and expedite the examination of the present application. The undersigned can be reached at the number listed below.

II. The Present Office Action Has Been Improperly and Prematurely Deemed Final

Applicant respectfully submits that the present Office Action has been improperly and prematurely deemed final. Under M.P.E.P. § 706.07(a), second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement. Here, the exception noted above applies as the Examiner has introduced a new ground of rejection, i.e., a non-statutory subject matter rejection based on 35 U.S.C. § 101, which was not necessitated by amendment nor based on an information disclosure statement. Rather, prosecution was "reopened" in light of the Examiner conference decision of July 17, 2009, in response to Applicant's Pre-Appeal Brief submitted on May 7, 2009. *See* Office Action at page 2. The non-statutory subject matter rejection was not raised before the present Office Action and this is Applicant's first opportunity to address the merits of such a rejection. Accordingly, Applicant respectfully requests that the present rejections be deemed "non-final" under 37 CFR § 1.111 and the finality of the present Office Action be withdrawn.

III. The Provisional Double Patenting Rejections of Claims 1-17

Claims 1-17 remain provisionally rejected on the ground of nonstatutory obviousness-type patenting as being unpatentable over claims 1-20 of copending United States Patent Application No. 10/761,883, claims 1-15 of copending United States Patent Application No. 10/761,894, and claims 1-24 of copending United States Patent Application No. 10/972,765. *See id.* Applicant respectfully disagrees and traverses this rejection on the following grounds.

First, the rejection fails to meet the requirements set forth in M.P.E.P. § 804. Specifically, any obviousness-type double patenting rejection should make clear: (a) the differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and (b) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent. *See* M.P.E.P. § 804. The reasoning set forth in the Office Action is conclusory at best and fails to do a proper analysis of claim scope between the respective sets of claims let alone identify any of the numerous differences between these claims. The Examiner only states en masse that all claims in all four applications are patentably indistinct because they vaguely share some similar functionality and objectives without regard to the limitations in the particular claims.

Applicant respectfully submits that claims 1-17 are patentably distinct from the pending claims of the referenced related applications. More specifically, all claims in U.S. Patent Application No. 10/972,765 recite the limitation, “terminate the mail transfer session with the sending MTA by sending an error message in accordance with the email delivery protocol, the error message comprising a reprieve message” or some variant. The present application does not claim any limitations directed to an error message comprising a reprieve message. With regard to U.S. Patent Application No. 10/761,883, now U.S. Patent No. 7,490,128, which issued on February 10, 2009, with a single claim. Comparison of that claim with any claim in the present application shows the single claim contains a large number of limitations not recited in any claim in the present application. With regard to U.S. Patent Application No. 10/761, 894, claim 1 of the present application and claim 1 of the ‘894 application are directed to a different intercepting means. The intercepting means in the ‘894 application intercepts a “.r\n” end-of-message indicator reply, whereas the intercepting means in the present application intercepts the RCPT reply. In the former case, the intercepting means rejects an unsolicited message by sending an error reply to MTA_0, whereas in the latter case (present application), the RCPT reply to MTA_1 is modified thereby diverting the unsolicited message. The actions are completely different, in the former case the a message is ultimately not received and in the latter case the message is diverted to an alternate email account. Similarly, a comparison of claim 16 of the ‘894 application and claim 14 of the present application show a similar patentable distinction as does a comparison of claim 17 of the ‘894 and claim 15 of the present application and so forth.

Nonetheless, in order to expedite the allowance of this application, Applicant is concurrently filing a terminal disclaimer. However, Applicant reiterates that the filing of the terminal disclaimer to obviate the double patenting rejection is not an admission of the propriety of the rejection. *See Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991) (“filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.”).

The Examiner is requested to withdraw the instant provisional double patenting rejection.

IV. The Non-Statutory Subject Matter Rejections of Claims 1-16

Claims 1-13 stand rejected under 35 U.S.C. § 101, as allegedly failing to fall within a statutory category of invention. *See* Office Action at page 3. Particularly, the Examiner contends that “the claimed “unsolicited message diverting communications processor” is directed to a software program” and is therefore non-statutory under 35 U.S.C. § 101. *Id.* The Examiner, however, notes that a “networked computer comprising an unsolicited message diverting communications processor” would be statutory. *Id.* Applicant respectfully disagrees with the Examiner’s reasoning for invoking this rejection as a “processor” is clearly a “machine” that is eligible for patent protection under 35 U.S.C. § 101. Nonetheless, Applicant has amended claims 1-13 as suggested by the Examiner to overcome this rejection.

Claims 14-16 also stand rejected under 35 U.S.C. § 101, as allegedly failing to fall within a statutory category of invention. *See id.* The Examiner contends that the instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. *Id.* The Examiner suggests, for instance, amending the “networked computer system” of claim 14 to a “networked computer.” *Id.* Although Applicant disagrees with the basis for this rejection, Applicant has amended claims 14 and 15 to recite that the respective methods are “implemented in a networked computer.” Claim 16 has been cancelled. Thus, claims 14 and 15 as amended are positively tied to a particular machine and fall within a statutory category of invention.

In view of these amendments, Applicant respectfully requests the Examiner to withdraw the non-statutory subject matter rejections of claims 1-16.

V. The Anticipation Rejection of Claims 16 and 17

Claims 16 and 17 stand rejected under 35 U.S.C. § 102(e), as allegedly being anticipated by U.S. Patent No. 7,249,175 to Donaldson. See Office Action at page 5. Although Applicant respectfully disagrees, claims 16 and 17 have been cancelled without prejudice. The anticipation rejection of claims 16 and 17 is thus moot.

VI. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously requested. In order to expedite resolution of any issues and to expedite passage of the present application to issue, the Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number if any comments, questions, or suggestions arise in connection with the present application.

No fee is believed to be necessary for entry and consideration of this Reply. In the event that a deficiency exists between the amount tendered and that required by the U.S. Patent & Trademark Office to enter and consider this Reply, or to keep the present application from being abandoned, please immediately contact the undersigned to remedy such deficiency.

Respectfully submitted,

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Dated: December 7, 2009

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